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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,708	02/23/2004	Robert Rice	BWORLD.0101	1463
22858 7590 11/26/2007 CARSTENS & CAHOON, LLP P O BOX 802334 DALLAS, TX 75380			EXAMINER JOHNSON, CARLTON	
			ART UNIT 2136	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE .PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/784,708

Applicant(s)

RICE ET AL.

Examiner

Carlton V. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-18 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-18 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responding to application papers filed on **2-23-2004**.
2. Claims **1, 2, 4 - 11, 13 - 18, 21 - 24** are pending. Claims **1, 4, 11, 13, 18** have been amended. Claims **3, 12, 19, 20** have cancelled. Claims **1, 11, 18** are independent.

### ***Response to Arguments***

3. Applicant's arguments filed 9/11/2007 have been fully considered but they are not persuasive.

- 3.1 Applicant argues that the referenced prior art does not disclose, "*seal is part of application*". (see Remarks Page 7-8)

The Nassiri prior art discloses in an embodiment wherein the notary seal is stored as a function embedded within the computer system (notary application) and the notary seal device is attached to the computer system. The electronic notary seal is embedded in the computer system or the notary application. This disclosure satisfies this part of the application requirement since the notary seal is attached to or part of the notary application. (see Nassiri paragraph [0096], lines 4-10; paragraph [0097], lines 24-28: seal function embedded within computer system, seal function cannot operate without notary application (distributed application))

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3.2 Applicant argues that the referenced prior art does not disclose, "*option for a Consent to Electronic Records (CER)*". (see Remarks Page 7)

The disclosure of an option for "Consent to Electronic Records" is well known in the art. A consumer (client) has to consent to not receive a paper copy of a transaction in lieu of access to an electronic copy of such a transaction. The capability to give a consumer (client) the right or option for acceptance or denial of access to transaction information in electronic form is well known in the art. The following definition dated from the year 2001 defines "Consent to Electronic Records" as stated on pages 22-23 of reference. (<http://www.ccs.neu.edu/home/tarase/BrodGibTaraseESig.pdf>) The Nassiri prior art discloses that the consumer initiates the paperless transaction; therefore consent to operate within a paperless environment is implied. (see Nassiri paragraph [0076], lines 5-10: request to accept paperless (electronic) transaction information; paragraph [0020]: concern for legal requirements for transactions)

3.3 Applicant argues *the rejection of the dependent claims*. (see Remarks Page 8)

Arguments for dependent claims are based upon above arguments for independent claims 1, 11, 18. The successful responses to arguments for independent claims 1, 11, 18, also successfully respond to the current arguments against the dependent claims 2, 4-10, 13-17, and 21-24.

3.4 The examiner has considered the applicant's remarks concerning a method, program, and system for notarizing and verifying documents within a distributed computer network by the creation of an electronic version of the document on a client

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computer, which is then encrypted and stored on a secure server. The stored electronic document may be retrieved by any client in the computer network. The signing party is then notified of the electronic document's identity and directed to the location of a certified notary within the signing party's geographic vicinity and retrieves the electronic document on the notary's client computer. The signing party then electronically signs the document. The notary verifies the transaction and affixes his electronic signature and an electronic image of his notary seal to the document before saving it on the server. Applicant's arguments have thus been fully analyzed and considered but they are not persuasive.

After an additional analysis of the applicant's invention, remarks, and a search of the available prior art, it was determined that the current set of prior art consisting of Nassiri (20020143711) and "Electronic Signatures" discloses the applicant's invention including disclosures in Remarks dated September 11, 2007.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 2, 4 - 11, 13 - 18, 21 - 24 are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Nassiri et al.** (US Patent No. **20020143711**) in view of "Electronic Signatures").

**Regarding Claims 1, 11, 18**, Nassiri discloses a method, system, computer program product in a computer readable medium for verifying a document via a distributed computer network, the method comprising the steps of:

- (b) storing the electronic document on a server in the computer network; (see Nassiri paragraph [0081], lines 2-27; paragraph [0080], lines 1-5: upload, download, store electronic document on host system (i.e. server))
- (c) retrieving the electronic document using a notary application via a second client in the computer network; (see Nassiri paragraph [0080], lines 1-5: download (i.e. retrieve) electronic document)
- (f) electronically affixing a verifying party's signature and seal to the electronic document using said notary application via the second client, wherein said seal is stored electronically by said notary application, and wherein the verifying party may be any certified party that has authority by law to verify and authenticate the signer of a document; (see Nassiri paragraph [0095], lines 1-6: attach notary digital signature, notary seal for notary public to electronic document; paragraph [0096], lines 4-10; paragraph [0097], lines 24-28: seal function embedded within the computer system, seal function cannot operate without notary application (distributed application)) and

(g) storing the signed, notarized, electronic document on said server. (see Nassiri paragraph [0102], lines 5-9: upload signed, notarized electronic document to host system (i.e. server))

Nassiri discloses the concern for legal ramifications of electronic signatures. (see Nassiri paragraph [0020]: concern for legal requirements for transactions) Nassiri does not specifically disclose whereby the option for acceptance of "Consent to Electronic Records". However, "Electronic Signatures" discloses wherein the option for a consumer to accept "Consent to Electronic Records" and further comprising:

(a) creating an electronic version of the document on a first client in the computer network, wherein said electronic document includes an acceptance option for a Consent to Electronic Records (CER); (see Nassiri paragraph [0072], lines 5-9: download (i.e. create) electronic document; paragraph [0045], lines 10-16: software, implementation means; paragraph [0045], lines 10-16: software, implementation means) and (see Electronic Signatures pages 22-23: procedures for option of acceptance for consent to electronic records)

(d) presenting a signing party with said acceptance option for said CER; (see Nassiri paragraph [0076], lines 5-10: request to accept paperless (electronic) transaction information) and (see Electronic Signatures pages 22-23: procedures for option of acceptance for consent to electronic records)

(e) electronically affixing at least one signing party's signature to the electronic document using said notary application via the second client only if said signing party accepts the CER; (see Nassiri paragraph [0076], lines 5-10: request to

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accept paperless (electronic) transaction information; paragraph [0095], lines 1-6: attach digital signature to electronic document) and (see Electronic Signatures pages 22-23: procedures for option of acceptance for consent to electronic records)

It would have been obvious to one of ordinary skill in the art to modify Nassiri as taught by "Electronic Signatures" to enable the capability for the option whereby a consumer to accept "Consent to Electronic Records". One of ordinary skill in the art would have been motivated to employ the teachings of "Electronic Signatures" in order to enable the capability to satisfy the legal requirements for electronic transactions. (see Electronic Signatures pages 22-23: procedures for option of acceptance for consent to electronic records)

**Regarding Claim 2**, Nassiri discloses the method according to claim 1, wherein the verifying party in step (e) is a notary. (see Nassiri paragraph [0044], lines 1-4; paragraph [0041], lines 8-11: notary public is verifier)

**Regarding Claims 4, 13**, Nassiri discloses the method, system, computer program product according to claims 3, 12, 19, wherein the seal is stored electronically in the notary application on the second client. (see Nassiri paragraph [0046], lines 9-12: attached notary seal device for notary public; paragraph [0045], lines 10-16: software, implementation means; paragraph [0096], lines 4-10; paragraph [0097], lines 24-28: seal function embedded within the computer system, seal function cannot operate



without notary application (distributed application))

**Regarding Claims 5, 14, 21**, Nassiri discloses the method, system, computer program product according to claims 1, 11, 18, wherein the verifying party's signature is stored on the second client. (see Nassiri paragraph [0046], lines 7-9: attached signature device for notary public; paragraph [0045], lines 10-16: software, implementation means)

**Regarding Claims 6, 17, 22**, Nassiri discloses the method, system, computer program product according to claims 1, 11, 18, wherein the signing party is provided with the location of an authorized verifying party nearest to the signing party's geographic location. (see Nassiri paragraph [0082], lines 5-11: nearest location for notary public (i.e. verifying party); paragraph [0045], lines 10-16: software, implementation means)

**Regarding Claims 7, 15, 23**, Nassiri discloses the method, system, computer program product according to claims 1, 11, 18, further comprising: creating and updating an electronic journal file containing information regarding the verification transaction, wherein said file is stored in a journal database for the verifying party. (see Nassiri paragraph [0047], lines 1-5; paragraph [0047], lines 8-14; paragraph [0101], lines 3-7: journal file for notarization; paragraph [0045], lines 10-16: software, implementation means)

**Regarding Claims 8, 16, 24**, Nassiri discloses the method, system, computer program

product according to claims 7, 15, 23, wherein the information stored in the journal file may include: sending party; time; dates; type of document; fees; type of notarization; signer's signature; and verification information. (see Nassiri paragraph [0101], lines 3-7; paragraph [0043], lines 6-15: journal contains notary information required by law; paragraph [0045], lines 10-16: software, implementation means)

**Regarding Claim 9**, Nassiri discloses the method according to claim 1, wherein an authorized verifying party can both create the electronic document and verify the electronic document. (see Nassiri paragraph [0044], lines 1-4; paragraph [0044], lines 7-11: notary; paragraph [0080], lines 1-5: download (i.e. create) electronic document; paragraph [0095], lines 1-6: verify electronic document)

**Regarding Claim 10**, Nassiri discloses the method according to claim 1, wherein a certified creator can only create the electronic document. (see Nassiri paragraph [0080], lines 15-19: confidential documents for specific individual)

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlton V. Johnson whose telephone number is 571-270-1032. The examiner can normally be reached on Monday thru Friday , 8:00 - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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*C. J.*

CVJ

November 13, 2007

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Examiner  
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*11/23/07*